

REMARKS

The present amendment is in response to the Office Action dated October 24, 2006, wherein the Examiner has rejected claims 1, 3, 6-8, 10-12, and 17-28. Claim 1 has been amended. Accordingly, claims 1, 3, 6-8, 10-12, and 17-28 remain pending in the present application. Reconsideration and allowance of pending claims 1, 3, 6-8, 10-12, and 17-28 in view of the amendments and the following remarks are respectfully requested.

A. Claim Rejections Under §102

Paragraph 1 of the Office Action rejects claims 1 and 11 under 35 U.S.C. § 102(b) as allegedly being unpatentable over Ghaem (U.S. 5,146,231) ("Ghaem"). Applicant respectfully traverse the rejection because Ghaem fails to teach, suggest or disclose each and every element of the claims.

At the outset, Applicant points out that claim 1 as previously amended is the result of several discussions with the Examiner during which it was ultimately agreed that the claim overcame the cited references of record, most notably the Ghaem reference. (See the Interview Summary submitted August 15, 2006). Accordingly, Applicant believes this rejection has already been addressed and overcome. Specifically, as Applicant has always maintained, Ghaem does not teach fixedly aligning the screen axis with the reference axis. As made clear in the present application this technique involves aligning the reference axis with the screen axis so that the two always point in the same direction. Once the two axes are fixedly aligned, then the direction of the screen axis, and thereby the direction the device is pointing, can be

determined. In other words, Ghaem does not teach a device that can be used as a directional pointer as previously acknowledged by the Examiner.

Nonetheless, the present Action now rejects claim 1 over Ghaem. However, contrary to the position proposed in the Action, not all the limitations defined by claim 1 are disclosed in Ghaem, and, therefore, claims 1 is patentably distinguishable over Ghaem.

First, the Action asserts that axis 21 corresponds to the reference axis of claim 1. In this case, Ghaem does not teach determining a relationship between a magnetic bearing and the reference axis. The text cited in the Action in support of the assertion that this limitation is met is actually referring to the ability of the device in Ghaem to determine an angle between true north and the screen axis 18. This aspect of Ghaem has no connection with determining a relationship between axis 21 and a magnetic bearing. In fact, Ghaem teaches that axis 21 is aligned with the magnetic bearing North and that this alignment is maintained so that it always point North. (See col. 4, lines 10-24). Accordingly, there would be no need to determine a relationship between axis 18 and a magnetic bearing, since it is known that axis 18 always points North.

Second, Ghaem does not teach aligning a reference axis with a screen axis as asserted in the Action. In making this assertion, the Action cites col. 4, lines 10-24; however, as noted above, the cited text is referring to the ability of the device in Ghaem to align a segment 21 with a predetermined compass heading of true north. (See col. 4, lines 10-24). Nowhere does the cited text say that a reference axis is aligned with the screen axis.

Third, Ghaem does not teach "determining a direction the screen axis is pointing based on the relation between the reference axis and the magnetic bearing . . .," as specified by claim 1 (a limitation that was added because the Examiner agreed that it was not found in Ghaem). As noted above there is no need to determine a relationship between axis 21 and a magnetic bearing because it is known to always point North. The Action asserts that this limitation is taught by Ghaem, citing text that indicates the angle between screen axis 18 and true north can be displayed on the screen. (See col. 6, lines 41-48); however, determining an angle between true north and the screen axis is not the same as determining the direction the screen axis is pointing based on a relationship between axis 21 and a magnetic bearing.

Applicant previously deleted the term "fixedly" from claim 1, as in fixedly aligning the reference axis with the screen axis, after discussion with the Examiner produced an agreement that the claim as previously presented overcame Ghaem. However, in an effort to advance prosecution of the present application, applicant has now amended claim 1 to more clearly explain the term "aligning." Specifically, Applicant has amended claim 1 to recite "aligning the reference axis with the screen axis so that the reference axis and the screen axis are always pointing in the same direction . . .," i.e., fixedly aligning the reference axis with the screen axis. As the Action clearly admits with respect to claim 12, Ghaem does not teach this limitation.

For all of the above reasons, Applicant respectfully requests withdrawal of the rejection as to claim 1. Claim 11 depends from claim 1 and is therefore allowable for at least the reasons stated with respect to claim 1. Applicant therefore also respectfully requests withdrawal of the rejection as to claim 11.

B. Claim Rejections Under §103

Paragraph 2 of the Action rejects claim 12 under 35 U.S.C. 103(a) as allegedly being unpatentable over Ghaem in view of Amro (U.S. Patent Serial No. 6,292,747). Applicant respectfully traverses this rejection because the Action fails to make out a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

To support a rejection under 35 U.S.C. 103(a), the cited references must teach each and every limitation of the claim. In this case, the rejection must fail because Ghaem and Amro, alone or in combination, fail to teach each and every element of claim 12.

Further, as the Federal Circuit has made clear, the first two criteria inform the prongs of the three-way test referred to in *Graham v. John Deere* in order to prevent the reliance on impermissible hindsight. In this case, the references fail to provide a proper motivation to combine the references or reasonable expectation of success.

As noted, certain embodiments disclosed in the present application are directed to a device that can be turned into a directional pointer. This is achieved by defining a screen axis and a reference axis. Determining a relationship between a magnetic bearing and the reference axis. Aligning the reference axis with the screen axis and displaying the direction associated with the reference axis on the display screen. Because the reference axis and the screen axis are fixedly aligned, the direction the device is pointing can be determined from the direction of the reference axis being displayed. (See the description of figure 2 on page 7).

Accordingly, claim 12 is directed to a device comprising a direction circuit configured to "determine a direction of the reference axis based on the relationship between the magnetic bearing and the reference axis; and align the reference axis with the screen axis so that the reference axis always points in the same direction as the screen axis; and wherein the user interface screen displays the direction of the reference axis."

Contrary to the position taken in the Action, Ghaem and Amro, taken either alone or in combination, fail to teach or suggest such subject matter. First, as noted above, and contrary to the position taken in the Action, Ghaem does not teach determining a relationship between the magnetic bearing and reference axis 21. The text cited in the Action in support of the allegation that this limitation is met is actually referring to the ability of the device in Ghaem to determine an angle between true north and the screen axis 18. This aspect has no connection with determining a relationship between axis 21 and a magnetic bearing.

Second, because Ghaem does not teach determining a relationship between a magnetic bearing and axis 21, it cannot teach determining a direction of axis 18 based on such a determined relationship as taught by claim 12. The Action asserts that this limitation is met; however, contrary to the assertion in the Action, the cited text teaches no such thing. Rather, the cited text says that the device in Ghaem can display compass headings with respect to a major axis 18. In fact, it is clear that one would never need to determine the direction of axis 21 with respect to a magnetic bearing, since it is known that axis 21 always points North, i.e., no determination of this fact is necessary because it is known.

Third, as recognized in the Office Action, Ghaem is silent on aligning a reference axis with a screen axis so that the reference axis and screen axis always point in the same direction.

Moreover, reliance upon Amro fails to cure the deficiencies of Ghaem. Amro teaches that a display can be configured to display the relative position of other vehicles relative to a first vehicle. The first vehicle is represented as an icon that is maintained in the middle of the display. The other vehicles are represented by icons that are free to move around. As the first vehicle moves, the display is rotated so that the direction and position of the icon representing the first vehicle in the display remains constant. The position of the icons representing the other vehicles then move within the display relative to the icon of the first vehicle as the first vehicle and the other vehicles actually move around.

Amro does note that the direction of the first vehicle can be represented by an arrow shown in figure 4; however, this arrow is apparently not something that is actually

displayed (see col. 4, lines 22-23) and appears to have been included to simply provide reference to the reader. In any event, Amro does not teach defining a reference axis, defining a screen axis, and aligning the reference axis with the screen axis so that the two always point in the same direction. Accordingly, Amro cannot make up for the deficiencies of Ghaem in this regard.

Further, and contrary to the position taken in the Action, one of skill in the art would not be motivated to combine Ghaem with Amro. Ghaem is the primary reference, accordingly the Action must show that one of skill in the art would be motivated to modify the teachings of Ghaem with the teachings of Amro to thereby achieve the invention as claimed in claim 12. In order to show that claim 12 would be obvious, the Action must point to some motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the teachings of Ghaem with those of Amro to achieve the invention claimed in claim 12.

First, one of skill in the art would not be motivated to modify the teachings of Ghaem with those of Amro, because to do so would render the Ghaem device non-functional. The device of Ghaem is an electronic compass, with an additional arrow that points in the direction of a target location. The Action has identified axis 21 as corresponding to the reference axis. As taught in Ghaem, axis 21 is aligned with magnetic north and always points towards magnetic north. Therefore, the device in Ghaem will not work if axis 21 is fixedly aligned with the screen axis so that the two always point in the same direction, because axis 21 would not point toward North, which is its only function. In fact, reference axis 21 would become meaningless as it would just be a line pointing straight up on the screen.

The Action seems to make the leap that if Ghaem was modified so that axis 21 were to point straight up, then the device would display the direction associated with the reference axis and therefore the direction the device is pointing. But the only place such a notion is taught is in the present application. No where does Ghaem state that if axis 21 is for some reason (not stated in Ghaem) aligned with axis 18 that suddenly the device would start displaying the direction of axis 21 on the screen. Ghaem is a compass. It displays the compass headings North, South, East and West. Axis, such as axis 21, are included that align with these headings and rotate on the screen as these headings change. Thus, the only purpose of axis 21 is to point toward true North.

Amro is no help in this regard either. Amro teaches tracking the location of vehicles relative to each other on a screen. Amro is not even directed to location or location tracking and certainly does not say that if a user for some reason (not stated in Amro) aligned a reference axis (not included in Amro) with a screen axis (also not included in Amro) so that the two always pointed in the same direction, then the device would start displaying the direction of the reference axis so that the user would know which way the device is pointing.

In other words, the leap made in the Action is not based on anything taught by the references relied on and therefore can only result from impermissible hindsight.

Second, the Action states that one of ordinary skill in the art would find it obvious to modify the teachings of Ghaem with the teachings of Amro so that the user can see in what direction they are heading on a map. But neither Amro nor Ghaem make any reference to the desirability of allowing a user to see in what direction they are heading on a map, nor would they. Most specifically, Ghaem would not teach that such was

desirable because Ghaem is an electronic compass the purpose of which is to show the direction of a target location relative to magnetic north. Ghaem has nothing to do with maps, does not include a map, and makes no reference to a map.

Amro is related to tracking the relative location of a first vehicle relative to a plurality of other vehicles. It has nothing to do with an electronic compass, tracking location or pointing out a target location. Accordingly, one of skill in the art would not be motivated to modify the teachings of Ghaem with the teachings of Amro, because the two are directed to unrelated applications (a point not addressed in the Action). At best the statement contained in the Action seems to be saying that the invention of claim 12 is obvious because one could combine Ghaem and Amro and somehow come up with the invention as claimed in claim 12; however. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). And although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992), and MPEP §2143.01. In this case, no such suggest or motivation exists.

For all the reasons stated above, Applicant respectfully requests withdrawal of the rejection of claim 12.

Paragraph 3 of the Action rejects claim 3 under 35 U.S.C. 103(a) as allegedly being unpatentable over Ghaem in further view of Farine (U.S. Patent 6,185,157).

Applicant respectfully traverses this rejection because claim 3 depends from claim 1

and is therefore allowable for at least the reasons stated with respect to claim 1.

Moreover, reliance upon Farine fails to cure the deficiencies of Ghaem. Accordingly, Applicant respectfully requests withdrawal of the rejection as to claim 3.

Paragraph 4 of the action rejects claim 6 under 35 U.S.C. 103(a) as allegedly being unpatentable over Ghaem in further view of Maruyama. Applicant respectfully traverses this rejection because Ghaem and Maruyama, alone or in combination, failed to teach each and every limitation of claim 6. First, applicant points out that applicant's representatives and the Examiner had already previously agreed that the claims as previously presented are patentable over the combination of Ghaem and Maruyama (See the Interview Summary submitted August 15, 2006). Accordingly, Applicant believes that this rejection has already been traversed. In any event, claim 6 is patentable for at least the reasons discussed above with respect to claim 1. Moreover, reliance upon Maruyama fails to cure the deficiencies of Ghaem. Accordingly, applicant respectfully request withdrawal of the rejection as to claim 6.

Paragraph 5 rejects claim 7 and 8 under 35 U.S.C. 103(a) as being allegedly unpatentable over Ghaem in view of Maruyama in further view of Johnson (U.S. Patent 6,366,856). Applicant respectfully traverses the rejection because claim 7 and 8 are dependent upon claim 1 and are allowable for at least the reasons stated above with respect to claim 1. Moreover, reliance upon Maruyama and Johnson fails to cure the deficiencies of Ghaem. Accordingly, Applicant respectfully requests withdrawal of the rejection as to claim 7 and 8.

Paragraph 6 rejects claim 10 under 35 U.S.C. 103(a) as allegedly being unpatentable over Ghaem in view of Maruyama in further view of Johnson in still further

view of Irie (U.S. Pub 2001/0007090). Applicant respectfully traverses the rejection because claim 10 is dependent upon claim 1 and is allowable for at least the reasons discussed with respect to claim 1. Moreover, reliance upon Maruyama, Johnson, and Irie fails to cure the deficiencies of Ghaem. Accordingly Applicant respectfully request withdrawal of the rejection as to claim 10.

Paragraph 7 rejects claim 17 to 23 as allegedly being unpatentable over Ghaem in further view of Amro in further view of Maruyama. Applicant respectfully traverses the rejections, because claim 17 to 23 are dependent upon claim 12 and are therefore allowable for at least the reasons discussed with respect to claim 12. Moreover, reliance upon Amro and Maruyama fails to cure the deficiencies of Ghaem. Accordingly, Applicant respectfully requests withdrawal of the rejection as to claim 17 to 23.

C. Conclusion

For all the foregoing reasons, allowance of claims 1, 3, 6-8, 10-12, and 17-28 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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